

**REMARKS**

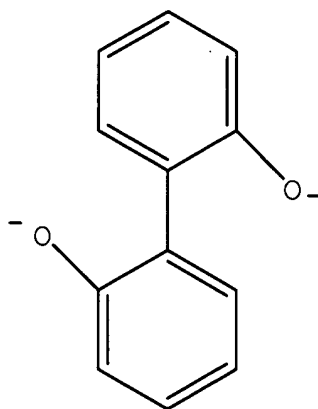
Claim 16 is currently being amended to include an additional embodiment therein, and new claims 18-20 are being added to additionally claim several additional embodiments of the inventive subject matter. These amendments do not introduce new matter within the meaning of 35 U.S.C. §132. Accordingly, entry of the amendments prior to examination is respectfully requested.

**1. Rejection of Claims 1-12 and 14-17 Under 35 U.S.C. 112, 2<sup>nd</sup>**

**Paragraph**

The Office Action states claims 1-12 and 14-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. In particular, the Office Action states,

It is not clear to the Examiner how the variable Y can be anything other than oxygen (-O-) when claim 1 recites a "process for preparing recemic metallocene biphenoxide complexes". It is understood in the art that a biphenoxide is a moiety of the formula,



biphenoxide

therefore, all the other groups that define the variable

Y do not meet the requirement of a biphenoxide in the preamble of claim 1. Note further that also the R groups bonded to both phenyl groups in the formula (I) are also limited to hydrogen if they are to meet also the requirements of the preamble. Please correct.

### RESPONSE

Applicant respectfully traverses the rejection of claims 1-12 and 14-17 as being indefinite. In particular, "A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification." See MPEP § 2111.01 III, § 2173.01, and § 2173.05(b) (III).

Applicant believes the phrase "process for preparing racemic metallocene biphenoxide complexes", along with the rest of claim 1, and claims 2-12 and 14-17 are properly defined in the specification and claims, and that one skilled in the art would appreciate the metes and bounds thereof. Accordingly, Applicant kindly requests the Examiner to withdrawal this rejection.

### 2. Rejection of Claims 1-12, and 16 Under 35 U.S.C. §102(a)

The Office Action states claims 1-12, and 16 are rejected under 35 U.S.C. §102(a) as being anticipated by WO 02/00672 (herein referred to as "Damrau, et al."). In particular, the Office Action states,

Claims 1-12 and 16 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by WO 02/00672, cited by Applicants. The WO patent publication discloses a method for the selective production of racemic metallocene complexes wherein a transition metal compound having a biphenoxide ligand is reacted with a cyclopentadienyl derivative of alkaline or alkaline earth metals. See Examples 1-4. Note that the reaction steps recited in claim 2 are well known in the art. See columns 10-14.

### **RESPONSE**

Applicant traverses the rejection of claims 1-12 and 16.

Applicant has submitted herein a Declaration signed by co-inventor Patrick MÜLLER, and a Declaration signed by two Basell Special Representative Authorities, Dr. Stefan SEELERT and Dr. Matthias WAGNER on behalf of Hans-Robert-Hellmuth DAMRAU, as Attachments B and C respectively. In particular, the Declarations state the disclosure in Damrau, et al. relied on by the Examiner in the pending Office Action was invented by co-inventors Patrick MÜLLER and Hans-Robert-Hellmuth DAMRAU themselves. See MPEP § 716.10.

In light of the above, claims 1-12 and 16 are therefore believed to be patentable over Damrau, et al. Accordingly, reconsideration and withdrawal of the rejection is requested.

### **3. Double Patenting Rejection**

The Office Action states,

Claims 1-10 and 16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,992,204 B2. Although the conflicting claims are not identical, they

are not patentably distinct from each other because the examined claims are either anticipated, or would have been obvious over, the patented claims. Here, claim 1 of U.S. Patent No. 6,992,204 B2 recite a method for the selective production of racemic metallocene complexes wherein a transition metal compound having a biphenoxide type-ligand is reacted with a cyclopentadienyl derivative of alkaline or alkaline earth metals. The method of claim 1 of U.S. Patent No. 6,992,204 B2 differs from the examined claim 1 in that also includes non-bridged as well as bridged phenoxide ligands, i.e., when the variable m is 1, 2 or 3. However, the '204 patent exemplifies the patented method when m is zero (see examples 1-4) which reads on the examined claims.

#### **RESPONSE**

Applicant has submitted a Terminal Disclaimer herein in order to obviate the above rejection.

In light of the above, reconsideration and withdrawal of the rejection is requested

#### **CONCLUSION**

Based upon the above remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the references of record. The Examiner is therefore respectfully requested to reconsider and withdraw all rejections and allow all pending claims 1 - 20. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned practitioner with any questions or comments.

Serial No. 10/532,570

Respectfully submitted,

By:

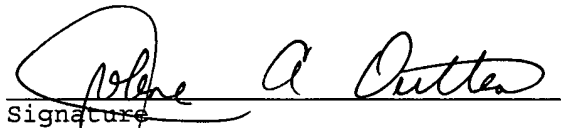


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on

October 17 2006.

  
Signature

October 17 2006  
Date